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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,280	02/01/2002	Taku Yokoyama	450101-02920	3537

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,280

Applicant(s)

YOKOYAMA, TAKU

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Applicant's amendment of 11/26/04 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 17-25 are rejected under 35 U.S.C. 102(b) as being anticipated by Tornetta (4870576).

For claim 1, Tornetta discloses an online sales system. Tornetta discloses a first terminal 100 that is used to register or upload information to a sales server 200. The sales server 200 is used to store the information received from terminal 100 and for outputting data to a second terminal (also 100). This system allows a seller to upload data to the sales server, and for a buyer to access the data at a 2nd terminal. The network is 20 in Tornetta. The language "for registering inheritance information associated with one or more robots", "for purchasinginformation" and "for receivinginformation" is reciting the intended use of the 1st terminal, sales server, and the 2nd terminal and is satisfied by Tornetta because the 1st terminal, 2nd terminal, and sales

server are all capable of registering, receiving, the claimed robot type of data. The data is not positively claimed and is only recited as the data that is intended to be registered, etc.. Even if the data were positively recited as being stored or registered or received, the type of data will not receive patentable weight because it is considered as non-functional descriptive material. *In re Gulack*, 217 USPQ 401 (CAFC 1983).

For claim 18, the mating means for combining a plurality of pieces of inheritance information is considered to be satisfied by Tornetta. This is because Tornetta discloses in column 8, lines 23-31 that a file is created that lists the serial numbers of properties that satisfy the search criteria. This file is made by combining a plurality of pieces of data (serial numbers) into one file. Information from separate files is merged into one file, which satisfies what is claimed.

For claims 18-21, with respect to the recitations about what kind of purchase is happening, they are the intended use of the system and are satisfied by the fact that Tornetta is capable of being used with robot data as claimed. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

For claim 22, the sales server 200 accepts data from and can transmit data to terminals 100 as claimed. The claimed means has a recited function of "for presenting registered inheritance information to said first terminal and said second terminal", and Tornetta is fully capable of presenting information as claimed.

For claim 23, the memory means is satisfied by the fact that Tornetta discloses that information is stored on a database by sales server 200. As stated previously the type of data will not receive patentable weight because it is considered as non-functional descriptive material. *In re Gulack*, 217 USPQ 401 (CAFC 1983).

For claim 24, Tornetta discloses a sales method as claimed. Tornetta discloses a method by which a seller can register information on a property and a buyer can search for properties to buy. The registration step is satisfied by the seller in Tornetta registering their information and having it stored by the sales server 200. Applicant should take notice that the recited "a registration step" is not even actually reciting the registration of anything. Turning on a computer that a person is going to use to register data satisfies what is claimed because this is a step in a process with the intent being for the registration of data. The "registration step" is for registering information, but it is not positively claimed that any registration is even taking place. This step is very broad and can arguably be satisfied by anything. The sales step is interpreted to be the step of a buyer receiving results from the inputted search criteria or alternatively can be considered satisfied by the seller uploading their data to the server. Both acts of receiving results and uploading of seller data are for the intended purpose of affecting a sale. As stated for the registration step, the sales step is very broad and is not

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positively reciting the sale of anything. With respect to the recitations that the data is inheritance information for robots, this is considered to be simply a recitation of the kind of data that is intended to be registered or sold and is satisfied by the fact that Tornetta can be used with robot data. As stated previously, the recited steps are not actually reciting the registration or sale of anything at all. Unless the data is being manipulated in some manner or used in some useful manner, this is just more non-functional descriptive material that does not serve as a limitation (if it were actually claimed). This is a very broad claim.

For claim 25, Tornetta discloses a sales server as claimed. The registration means is interpreted to be the act of saving data to the database of the sales means 200. The server of Tornetta is capable of being used with robot data and can be used in the intended use manner as recited by applicant.

3. Claim 17,19-23,25, are rejected under 35 U.S.C. 102(e) as being anticipated by Gabai et al. (6160986). Gabai discloses an online system for the downloading of robot personality type data. See col. 11, lines 8-20. The 1st terminal is considered inherent to Gabai because the robot data saved on the remote server has to get on the server by a 1st terminal (it has to be put on the server and saved initially) so the 2nd terminal 60 can download the data from the server. A network is inherent in Gabai. With respect to the intended use of the device such as it being for a "sale" of data, describing a type of purchase, and for storing specific type of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention

and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case Gabai is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sadakuni (6594649).

6. For claims 17,18,20,21,23,25, Sadakuni discloses a robot device that has personality data downloaded into the device from an external device such as a remote computer (registration means of claim 25). In column 13, lines 1-32, Sadakuni discloses that robot personality data can be downloaded (to a 2nd terminal) to the robot device from the Internet (Internet is the sales means of claim 25). Sadakuni discloses that by having the ability to get data from the Internet, data from multiple devices can be cross bred (mating means) to create a new system with a new personality. This cross breeding inherently requires uploading of robot data from a 1st terminal to put the data

on the Internet so it can be cross bred. A network is inherent in Sadakuni. Sadakuni does not disclose a "server". It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a server in the system of Sadakuni so that the robot data can be stored and accessed via the Internet. The use of a server to manage and store data on the Internet is well known and obvious to one of ordinary skill in the art. With respect to the intended use of the device such as it being for a "sale" of data, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use (which in the instant case is fully capable of the intended use limitations) then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

For claim 19, Sadakuni discloses a recordable medium in column 13.

For claim 22, the registration means is considered to be present in Sadakuni.

For claim 24, Sadakuni discloses the invention substantially as claimed.

Sadakuni discloses that robot personality data can be stored for downloading on/from the Internet. This satisfies the claimed registration step of registering inheritance information on-line. Sadakuni does not disclose the "selling" of the robot personality data. It would have been obvious to one of ordinary skill in the art at the time the invention was made to sell the robot data so that one can make money. Prior to the

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filing date of this application it was in the public domain that various companies are selling robots for personal use where the robots possess a personality determined by personality data. In view of this fact and in view of the fact that one can find just about everything for sale nowadays the concept of "selling" robot personality data (noting that robots that use the data are already being sold in the retail marketplace) is considered obvious to one of ordinary skill in the art.

7. Applicant's arguments filed 11/26/04 have been fully considered but they are not persuasive.

With respect to Gabai, applicant has more or less repeated the claim language and stated that the prior art does not disclose what is claimed. This is an argument that is vague and non-specific in content. The examiner has identified what he considered the terminals and server to be in the applied prior art and this has not been discussed at all. The examiner has also indicated how the intended use language has been interpreted and this has not been addressed. Why is this interpretation incorrect? Stating that the prior art does not disclose what is claimed and repeating most of the claim is not persuasive and is not very much of an argument for the examiner to respond to. The rejection is deemed proper.

With respect to Sadakuni, applicant's argument is the same as for Gabai. Applicant has more or less repeated the claim language and stated that the prior art does not disclose what is claimed. This is an argument that is vague and non-specific in content. The examiner has identified what he considered the terminals and server to

be in the applied prior art and this has not been discussed at all. The examiner has also indicated how the intended use language has been interpreted and this has not been addressed. Why is this interpretation incorrect? Nothing has been stated about the obviousness statement in the 103 rejection so with no traversal of the obviousness statement, the examiner assumes applicant to be in agreement that the use of a server is obvious. Stating that the prior art does not disclose what is claimed and repeating most of the claim is not persuasive and is not very much of an argument for the examiner to respond to. The rejection is deemed proper.

With respect to the statement about the dependent claims that they "are therefore believed patentable for *at least* the same reasons.", applicant is reminded of 37 CFR 1.111. If applicant has additional arguments of why the claims are patentable over the prior art they need to be presented in a timely manner. Because no arguments for the dependent claims have been presented, and because the arguments for the independent claims are non-persuasive, the examiner takes the lack of arguments for the dependent claims as applicant's acquiescence as to the merits of their rejection.

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 703-308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


DENNIS RUHL
PRIMARY EXAMINER